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KONRAD RAYNES & VICTOR, LLP 315 S. BEVERLY DRIVE # 210 BEVERLY HILLS, CA 90212			ALI, MOHAMMAD	
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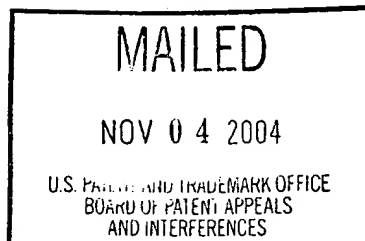
The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAGDISH MOOLJEE NAGDA, ROBERT CURT NIELSEN,
and GERRI LYNN PEPER



Appeal No. 2004-0752
Application No. 09/388,261

ON BRIEF

Before JERRY SMITH, BLANKENSHIP, and SAADAT, Administrative Patent Judges.
BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-32, which are all the claims in the application.

We reverse.

BACKGROUND

The invention relates to generation and delivery of marketing material that is customized for particular customers. Representative claim 1 is reproduced below.

1. A automated creation and delivery method for generating output material, comprising:

generating a customer record in a first database table to include fields specifying at least one product, customer preferences, and a selected output method to deliver generated output material on the product specified in the customer record;

receiving at least one customer record in the first database table to process;

accessing at least one content file by querying a second database table using values in one received customer record;

generating the content of each accessed file into the output material;

determining a selected one of a plurality of delivery options from the customer record; and

transmitting the output material via the determined delivery option to the customer specified in the customer record.

The examiner relies on the following references:

Tackbary et al. (Tackbary)	5,555,496	Sep. 10, 1996
Dedrick	5,717,923	Feb. 10, 1998

Claims 1-32 stand rejected under 35 U.S.C. § 103 as being unpatentable over Dedrick and Tackbary.

We refer to the Final Rejection (Paper No. 9) and the Examiner's Answer (Paper No. 19) for a statement of the examiner's position and to the Brief (Paper No. 18) and

the Reply Brief (Paper No. 20) for appellants' position with respect to the claims which stand rejected.

OPINION

Appellants argue in the Brief that the rejection fails to show disclosure or suggestion of the claimed combination that includes accessing at least one content file by querying a second database. Instant claim 1 requires generating a customer record in a first database table to include specific fields, and "accessing at least one content file by querying a second database table using values in one received customer record."

The statement of the rejection applied against claim 1 (Answer at 3-4) contends that Dedrick discloses generating a record in a first database table and querying a second database table using values in one received customer record. The rejection does not specify the elements disclosed in Dedrick that are deemed to correspond to the claimed first and second database tables. However, in response to appellants' arguments, the examiner asserts that "Dedrick discloses...user profile data (first database) for the end user from the personal database (second database) to determine the search criteria (query) for this end user...." (Answer at 6.)

Dedrick discloses an electronic network (Fig. 1) that includes client systems 12 coupled to metering servers 14. A client system 12 (Fig. 2) contains a personal profile database 27 that contains personal profile information and preferences with respect to

the user. Col. 5, ll. 50-62; col. 6, ll. 52-54. A metering server 14 (Fig. 3) contains a user profile database 30 that comprises aggregate profile data collected from the client systems 12. User profile database 30 thus contains profile data that server 14 may periodically request and collect from client systems 12. Col. 9, ll. 25-33.

We agree with appellants that Dedrick's disclosure of the user profile database 30 and the personal profile database 27 does not teach or suggest the first and second database tables as claimed. The reference does teach generating a customer record in a "first" database table (e.g., personal profile database 27) to include fields specifying customer preferences, although we note that the rejection neglects to point out a teaching relating to fields specifying "at least one product." The rejection apparently relies on Tackbary for an alleged teaching relating to a "selected output method," or delivery options.

In any event, the examiner seems to admit that database 27 and database 30 of Dedrick do not teach or suggest the limitations of the claims, by alleging, in response to appellants' arguments, that the claimed databases are "functional equivalents" or "would have been obvious." (Answer at 7.) In view of the actual teachings of Dedrick, and the lack of evidence in support of the assertions of equivalent functions or obviousness, the rejection must fail.

The examiner's responsive arguments in the Brief refer to a feature of Dedrick that is closer to the limitations of claim 1 with respect to accessing a content file by querying a database table using values in one received customer record. The Answer,

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at pages 6 through 7, refers to actions of the "appraisal agent" described at column 8, lines 27 through 31.

Dedrick, at column 8, line 20 through column 9, line 14, describes an appraisal agent 28 on client system 12 (Fig. 2). The appraisal agent may access user profile data from personal profile database 27 to determine search criteria for the user, and "work its way back through the system 10" (Fig. 1) to locate electronic information which matches the search criteria. However, as appellants note (Reply Brief at 2), the examiner has not shown how this might teach "generating the content of each accessed file into the output material," as recited in claim 1. Moreover, appraisal agent 28 does not access a content file by querying "a second database table" -- personal profile database 27, according to the rejection -- using values in a received customer record, but accesses information from yellow page servers 22 (Figs. 1 and 5).

Since the remaining independent claims (12 and 22) contain limitations similar to those of claim 1 for which the rejection falls short, we do not sustain the rejection of any of the claims on appeal.

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CONCLUSION

The rejection of claims 1-32 under 35 U.S.C. § 103 as being unpatentable over Dedrick and Tackbary is reversed.

REVERSED

Jerry Smith
JERRY SMITH

JERRY SMITH
Administrative Patent Judge

Howard B. Blankenship

HOWARD B. BLANKENSHIP
Administrative Patent Judge

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